

Remarks/Arguments:

The pending claims are 54-65. Claim 63 has been withdrawn from consideration.

Claims 54-62 and 64-65 have been rejected under 35 U.S.C. § 102(e) as anticipated by Martin (U.S. Patent No. 5,575,817).

Request for Approval of Rejection by Technology Center Director

As noted in the Request for Interference and Preliminary Amendment dated February 24, 2004, claims 54-60 have been substantially copied from U.S. Patent No. 6,524,336, which issued to Papazolguou et al. on February 25, 2003. Based on the foregoing, the MPEP requires the approval of the TC Director before these claims may be rejected over Martin. Specifically, MPEP § 1003 states, in part:

The following is a list of matters which are submitted to the appropriate Technology Center Director, together with a reference to any section of this manual where such matters are more fully treated.

* * * * *

6. Actions which hold unpatentable claims copied from a patent for interference purposes where the grounds relied upon are equally applicable to the patentee, MPEP § 2307.02.

For these reasons, Applicants request that all of the claim rejections be withdrawn unless the rejection is approved by the TC Director.

Request for Reconsideration of the Rejection Based on Martin

As noted in the Office Action, "[t]he present invention claims priority based on EP 94400284.9 (2/9/1994) and EP 94401306.9 (6/10/1994), which are prior to the Martin-'817 reference." Applicants agree. The Office Action also states:

[T]he seniority of the Martin-'817 and this application will depend on a result of one interference case between Martin-'817 and a parent case of this present application. If the Applicant does not agree that Martin-'817 is prior art, the Examiner will have to wait until after the interference case between Martin-'817 and the parent case of this application has been resolved so that further proper action can be taken.

In a telephone interview on December 5, 2008, the "one interference case" referenced in the Office Action was clarified to include Interference No. 104,083 and Interference No. 104,192.

As a preliminary matter, the characterization in the Office Action of the relationship between this application and the application involved in the interferences requires clarification.

This application is a continuation of Serial No. 08/463,987, filed June 5, 1995, now pending, which is a division of Serial No. 08/317,763, filed October 4, 1994, now U.S. Patent No. 5,609,627, which is a continuation-in-part of Serial No. 08/312,881, filed September 27, 1994, now pending. The present application is also a continuation-in-part of Serial No. 08/312,881. None of these parent applications were or are involved in an interference.

Instead, Application No. 08/461,402 was involved in the two interferences referred to above: Interference No. 104,083 and Interference No. 104,192. Application No. 08/461,402 is related to the present application in that it is a division of Application No. 08/317,763, filed October 4, 1994, referenced above. That is, the present application is a continuation of a division of the '763 application, and the '402 application that was involved in the interferences is a divisional of the '763 application. Accordingly, both the '402 application and the present application trace their priority back through the '763 application. As noted above, the present application is also a continuation-in-part of Serial No. 08/312,881.

Interference No. 104,083

Interference No. 104,083 involved the '402 application and Martin-'817.

The Count of Interference No. 104,083 is as follows:

An apparatus for reinforcing a bifurcated lumen comprising:
a first section, configured to be positioned with the lumen, comprising:
an upper limb, configured to fit within the lumen upstream of the bifurcation;
a first lower limb, configured to extend into a first leg of said bifurcation when said first section is positioned in the lumen, and
a second lower limb, shorter than said first lower limb, and configured so that when said first section is positioned in the lumen, said second lower limb does not extend into a second leg of said bifurcation.

The termination of Interference No. 104,083 is shown by the Judgment of the Board on March 10, 1999, a copy of which is submitted herewith. It includes the following orders:

"It is ORDERED that judgment as to the subject matter of count 1 is entered against junior party Martin and awarded in favor of senior party Cragg."

"It is ORDERED that Eric C. Martin is not entitled to a patent containing claim 1 of his involved patent, which corresponds to count 1."

"It is ORDERED that on this record, Andrew H. Cragg and Michael D. Dake are entitled to a patent containing their application claim 89 which corresponds to the count."

Interference No. 104,192

Interference No. 104,192 involved the '402 application, Martin-'817, and Application Serial No. 08/463,836 of Fogarty et al. The Count of Interference No. 104,192 is as follows:

An apparatus for reinforcing a bifurcated lumen comprising:
a first section, configured to be positioned within the lumen, comprising:
an upper limb, configured to fit within the lumen upstream of the
bifurcation;
a first lower limb, configured to extend into a first leg of said bifurcation
when said first section is positioned in the lumen, and
a second lower limb, shorter than said first lower limb, and configured so
that when said first section is positioned in the lumen, said second lower limb
does not extend into a second leg of said bifurcation,
and further comprising
a second section configured to be positioned separately within the lumen
and joined to said second lower limb of the first section, effectively extending
said second lower limb into said second leg of said bifurcation. (see, Board's
Final Decision and Judgment dated July 27, 2001 at pp. 5-6, referenced again
below)

The termination of Interference No. 104,192 is shown by the following documents
which have been previously submitted in this application:

Final Decision and Judgment of the Board of Patent Appeals and Interferences
dated July 27, 2001 (submitted along with an Information Disclosure Statement
filed on February 7, 2007), which includes the following orders:

"ORDERED that judgment as to the subject matter of the count is herein
entered against junior party ERIC C. MARTIN and also against junior
party ANDREW H. CRAGG and MICHAEL D. DAKE;

FURTHER ORDERED that the junior party ERIC C. MARTIN is not entitled
to his patent claims 2-17 which correspond to the count;

FURTHER ORDERED that junior party ANDREW H. CRAGG and MICHAEL
D. DAKE are not entitled to their application claims 55, 59, 62-65, 88 and
90 which correspond to the count; and

FURTHER ORDERED that a copy of this paper shall be given a paper
number and filed in the respective involved application/patent of the
parties."

Memorandum Opinion and Final Judgment of the United States District Court for
the District of Columbia, Civil Action No. 01 CV 2015, dated March 31, 2006,

also submitted along with the Information Disclosure Statement filed on February 7, 2007.

Decision of the United States Court of Appeals for the Federal Circuit in *Boston Scientific Scimed, Inc. v. Medtronic Vascular, Inc.*, No. 2006-1434, dated August 8, 2007, submitted along with an Information Disclosure Statement filed on August 23, 2007.

In the July 21, 2001 Final Decision, the Board granted Motion 12 of party Fogarty, which had requested the Board

to deny the senior party [Cragg and Dake] the benefit of EP94400284.9 and EP94401306.9 on grounds that neither application was filed by (i) the individual now identified as the inventor or (ii) on his behalf by his legal representatives or assigns. (Final Decision at p. 2, 8, and 23)

The Board also entered the following Order, among others:

It is . . . FURTHER ORDERED that junior party ANDREW H. CRAGG and MICHAEL D. DAKE are not entitled to their application claims 55, 59, 62-65, 88 and 90 which correspond to the count. (Final Decision at p. 69)

In the District Court proceeding, the stipulated issue to be resolved was:

Whether the Board erroneously affirmed its Grant of Fogarty *et al.* (Medtronic) Motion 12 in its July 27, 2001 Final Decision denying Cragg *et al.* (Scimed) benefit of the February 9, 1994 filing date of its European application No. 94400284.9 as a date of invention for the subject matter of the single count in Interference No. 104,192. (*Scimed Life Systems*, slip op. at p. 7.)

The District Court found that

the Board did not err in its granting of party Fogarty's (Medtronic's) motion No. 12 which denied Cragg *et al.* (Scimed) the benefit of the earlier filing date of European application No. 94400284.9 and affirms the Board's award of priority to Fogarty *et al.* (Medtronic) in its July 27, 2001 Final Decision and Judgment. (*Scimed Life Systems*, slip op. at p. 14.)

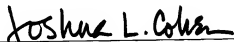
In the August 8, 2007 Opinion, the Federal Circuit affirmed the decision of the U.S. District Court for the District of Columbia. *Boston Scientific Scimed*, slip op. at 7.

Those Interferences are now final, in that Applicants will not file any further appeals. The Examiner is invited to consider the resolution of those Interferences.

Conclusion

In view of the foregoing, reconsideration of this application and the rejection based on Martin is respectfully requested.

Respectfully submitted,



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Enclosure: March 10, 1999 order, Interference No. 104,083

JLC/SW/dhm

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The Director is hereby authorized to charge or credit Deposit Account No. 18-0350 for any additional fees, or any underpayment or credit for overpayment in connection herewith.